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EXAMINER

MORGAN, ROBERT W

ART UNIT PAPER NUMBER

3626

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,815

Applicant(s)

ANDROS ET AL.

Examiner

Robert W. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☒ Claim(s) 28 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Application

1. This communication is in response to the application filed on December 29, 2000. The applicants have not filed an Information Disclosure Statement (IDS) statement in this case as of the date of this office action. The applicants have amended the claims on May 19, 2003 and the amended claims, claims 1-37, are pending in this application and have been examined.

Claim Objections

2. Claims 28 and 36 objected to because of the following informalities: It is not clear from the body of the claim language in claims 28 and 36 how these claims are further limiting the claims which they are dependent from, claims 27 and 35, respectively. Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 22-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

5. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the

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"progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

6. In the present case, claims 22-37 recite abstract ideas. The recited steps of merely determining insurance eligibility information for consumers does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed manually by a user. For example, a user could receive a paper list and determine insurance eligibility by simply calling (via telephone) the insurance companies to determine insurance eligibility. The calls could be answered (on the other end of the line) by a computerized system in which the user could enter a patient's name and/or identification to determine insurance eligibility.

7. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 22-28 and 30-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Doyle.

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Doyle is directed towards a computerized medical insurance system including means to automatically update member eligibility files at pre-established intervals.

As per claim 22, which is directed towards a method of determining insurance eligibility information for consumers, Doyle teaches the steps of receiving a list of one or more consumers (Col. 2, Ln. 42-64, Col. 5, Ln. 16-32 and Col. 5, Ln. 51-64), querying at least one of a plurality of network locations specifying insurance eligibility information to determine whether one or more consumers is insured by the insurance carrier (Figure 2B), and indicating which of the consumer of the list have insurance (Figure 2B and Col. 5, Ln. 16-32).

As per claim 23, in Doyle the network locations are insurance company carrier systems (Col. 2, Ln. 45-48).

As per claim 24, in the system of Doyle, for the consumers having insurance, the system specifies which insurance carrier provides insurance for the consumer (Col. 2, Ln. 42-64 and Col. 5, Ln. 16-32).

As per claim 25, the system of Doyle determines that at least one of the consumers is insured by two or more insurance carriers (Col. 2, Ln. 16-32).

As per claims 26-28, Doyle fails to teach, per se, the concept of specifying which insurance carriers provide insurance and which carrier is a primary carrier. However Doyle does teach that the insurance administration database contains a listing of the dollar amounts payable for a given type of diagnosis (Col. 2, Ln. 59-64). The examiner takes the position that from this information in Doyle the user can determine which insurance carrier is the primary carrier (assuming the primary carrier while contain the highest dollar amounts payable of all the insurance carriers).

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As per claim 30, which is directed towards a machine readable storage medium with a plurality of code sections, Doyle teaches the steps of receiving a list of one or more consumers (Col. 2, Ln. 42-64, Col. 5, Ln. 16-32 and Col. 5, Ln. 51-64), querying at least one of a plurality of network locations specifying insurance eligibility information to determine whether one or more consumers is insured by the insurance carrier (Figure 2B), and indicating which of the consumer of the list have insurance (Figure 2B and Col. 5, Ln. 16-32).

As per claim 31, in Doyle the network locations are insurance company carrier systems (Col. 2, Ln. 45-48).

As per claim 32, in the system of Doyle, for the consumers having insurance, the system specifies which insurance carrier provides insurance for the consumer (Col. 2, Ln. 42-64 and Col. 5, Ln. 16-32).

As per claim 33, the system of Doyle determines that at least one of the consumers is insured by two or more insurance carriers (Col. 2, Ln. 16-32).

As per claims 34-36, Doyle does not explicitly recite, per se, the concept of specifying which insurance carriers provide insurance and which carrier is a primary carrier. However, Doyle does teach that the insurance administration database contains a listing of the dollar amounts payable for a given type of diagnosis (Col. 2, Ln. 59-64). The examiner takes the position that from this information in Doyle the user can determine which insurance carrier is the primary carrier (assuming the primary carrier while contain the highest dollar amounts payable of all the insurance carriers).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-5, 7, 14-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,774,671 to Satoh in view of US Patent Number 5,675,637 to Szlam.

Satoh is directed towards a service changeable system at an information center while Szlam is directed towards a method for automatically obtaining and presenting data from multiple data sources,

As per claim 1, which is directed towards a method for collecting and providing consumer information to a user, Satoh teaches the steps of receiving from a requesting computer a request for consumer information from a user (the request identifying a customer) and retrieving the requested consumer information corresponding to the identified consumer from at least one network location (the consumer information comprises at least one data item) (Col.1, Ln. 59-Col. 2, Ln. 13 and Col. 5, Ln. 65-Col. 6, Ln. 17).

Satoh fails to teach the step of transferring at least one data item from the retrieved consumer information to a corresponding field in a user interface in a requesting computer (screen scraping). However this feature is well-known in the art as evidenced by Szlam (Col. 12, Ln. 4-28 and Col. 17, Ln. 53-Col. 18, Ln. 5). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to have included this screen-scraping feature as taught in Szlam in order to have provided the user with a method for consolidating multiple

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sources of information located on various screens as recited in Szlam (Col. 5, Ln. 25-Col. 6, Ln. 18).

As per claim 2, in Satoh the user is authenticated (Col. 4, Ln. 31-39).

As per claim 3, in Satoh the user information comprises demographic information (Figure 8 and Col. 4, Ln. 32-42).

As per claims 4-5, in Satoh the user is provided information regarding services (Col. 1, Ln. 59-Col. 2, Ln. 13) and the examiner takes the position that it is within the scope of Satoh that these services include consumer insurance and credit card information.

As per claim 7, the combined system of Satoh in view of Szlam uses screen scraping technology as noted in the rejection of claim 1.

As per claim 14, which is directed towards a machine readable storage medium, Satoh teaches the steps of receiving from a requesting computer a request for consumer information from a user (the request identifying a customer) and retrieving the requested consumer information corresponding to the identified consumer from at least one network location (the consumer information comprises at least one data item) (Col.1, Ln. 59-Col. 2, Ln. 13 and Col. 5, Ln. 65-Col. 6, Ln. 17).

Satoh fails to teach the step of transferring at least one data item from the retrieved consumer information to a corresponding field in a user interface in a requesting computer (screen scraping). However this feature is well known in the art as evidenced by Szlam (Col. 12, Ln. 4-28 and Col. 17, Ln. 53-Col. 18, Ln. 5). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to have included this screen-scraping feature as taught in Szlam in order to have provided the user with a method for consolidating multiple

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sources of information located on various screens as recited in Szlam (Col. 5, Ln. 25-Col. 6, Ln. 18).

As per claim 15, in Satoh the user is authenticated (Col. 4, Ln. 31-39).

As per claim 16, in Satoh the user information comprises demographic information (Figure 8 and Col. 4, Ln. 32-42).

As per claims 17-18, in Satoh the user is provided information regarding services (Col. 1, Ln. 59-Col. 2, Ln. 13) and the examiner takes the position that it is within the scope of Satoh that these services include consumer insurance and credit card information.

As per claim 20, the combined system of Satoh in view of Szlam uses screen scraping technology as noted in the rejection of claim 1.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh and Szlam as applied to claim 1 above, and further in view of US Patent Number 6,349,299 to Spencer.

Satoh and Szlam fail to teach the step of presenting the retrieved consumer information to the user for verification; however, this feature is well known in the art as evidenced by Spencer (Col. 10, Ln. 12-27). At the time the invention was made one of ordinary skill in the art would have been motivated to have included this user verification feature in the system of Satoh and Szlam, as taught in Spencer, in order to provide an additional level of security and to prevent unauthorized access.

13. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 4,876,643 to McNeil.

McNeil is directed towards a parallel searching system having a master processor for controlling plural slave processors for independently processing respective search requests.

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As per claims 9-13, which are directed towards a system for collecting and providing consumer information to a user, McNeil teaches a buffer for receiving a user request for information from a requesting computer and for receiving consumer from a specified network location. McNeil also teaches an information matching system for retrieving the consumer information and a transfer agent (bus) for transferring at least one item of the consumer information in the retrieved consumer information to a corresponding field in a user interface in the requesting computer (Abstract and Col. 3, Ln. 35-50).

McNeil does not expressly teach the specific data recited in claims 9-13; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

14. Claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh and Szlam as applied to claim 1 above, and further in view of US Patent Number 6,349,299 to Spencer.

Satoh and Szlam fail to teach the step of presenting the retrieved consumer information to the user for verification; however, this feature is well known in the art as evidenced by Spencer (Col. 10, Ln. 12-27). At the time the invention was made one of ordinary skill in the art would have been motivated to have included this user verification feature in the system of Satoh and

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Szlam, as taught in Spencer, in order to provide an additional level of security and to prevent unauthorized access.

15. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh in view of Spencer and Szlam.

Claim 8 is directed towards a method for collecting and providing consumer demographic information and consumer insurance information to a user.

Satoh teaches the steps of a) receiving from a requesting computer a request for consumer information from a user (the request identifying a customer) and b) retrieving the requested consumer information corresponding to the identified consumer from at least one network location (the consumer information comprises at least one data item) (Col. 1, Ln. 59-Col. 2, Ln. 13 and Col. 5, Ln. 65-Col. 6, Ln. 17).

Satoh fails to teach the step of c) presenting the retrieved consumer information to the user for verification; however, this feature is well known in the art as evidenced by Spencer (Col. 10, Ln. 12-27). In Spencer, once the user verifies the information the record is created and stored in the desired database. At the time the invention was made one of ordinary skill in the art would have been motivated to have included this user verification feature in the system of Satoh, as taught in Spencer, in order to provide an additional level of security and to prevent unauthorized access.

Satoh teaches the step of d) receiving from a requesting computer a request for information from a user (the request identifying a consumer) and e) retrieving the requested consumer information corresponding to the identified consumer from at least one network

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location (the consumer information comprising at least one data item) (Col. 3, Ln. 50-Col. 4, Ln. 19 and Col. 17, Ln. 63-Col. 18, Ln. 5).

Satoh the user is provided information regarding services (Col. 1, Ln. 59-Col. 2, Ln. 13) and the examiner takes the position that it is within the scope of Satoh that these services include consumer insurance and credit card information.

Satoh and Spencer fail to teach the step of f) transferring at least one data item from the retrieved consumer information to a corresponding field in a user interface in a requesting computer (screen scraping). (In Spencer, once the user has verified their demographic information, the information is stored in a database (Col. 10, Ln. 23-27) but is not transferred to a field.) However this feature is well known in the art as evidenced by Szlam (Col. 12, Ln. 4-28 and Col. 17, Ln. 53-Col. 18, Ln. 5). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to have included this screen-scraping feature as taught in Szlam in order to have provided the user with a method for consolidating multiple sources of information located on various screens as recited in Szlam (Col. 5, Ln. 25-Col. 6, Ln. 18).

16. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh in view of Spencer and Szlam.

Claim 21 is directed towards a machine readable storage medium, having stored thereon a computer program having a plurality of code sections executable by a machine for causing the machine to perform several steps.

Satoh teaches the steps of a) receiving from a requesting computer a request for consumer information from a user (the request identifying a customer) and b) retrieving the requested consumer information corresponding to the identified consumer from at least one network

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location (the consumer information comprises at least one data item) (Col. 1, Ln. 59-Col. 2, Ln. 13 and Col. 5, Ln. 65-Col. 6, Ln. 17).

Satoh fails to teach the step of c) presenting the retrieved consumer information to the user for verification; however, this feature is well known in the art as evidenced by Spencer (Col. 10, Ln. 12-27). In Spencer, once the user verifies the information the record is created and stored in the desired database. At the time the invention was made one of ordinary skill in the art would have been motivated to have included this user verification feature in the system of Satoh, as taught in Spencer, in order to provide an additional level of security and to prevent unauthorized access.

Satoh teaches the step of d) receiving from a requesting computer a request for information from a user (the request identifying a consumer) and e) retrieving the requested consumer information corresponding to the identified consumer from at least one network location (the consumer information comprising at least one data item) (Col. 3, Ln. 50-Col. 4, Ln. 19 and Col. 17, Ln. 63-Col. 18, Ln. 5).

Satoh the user is provided information regarding services (Col. 1, Ln. 59-Col. 2, Ln. 13) and the examiner takes the position that it is within the scope of Satoh that these services include consumer insurance and credit card information.

Satoh and Spencer fail to teach the step of f) transferring at least one data item from the retrieved consumer information to a corresponding field in a user interface in a requesting computer (screen scraping). (In Spencer, once the user has verified their demographic information, the information is stored in a database (Col. 10, Ln. 23-27) but is not transferred to a field.) However this feature is well known in the art as evidenced by Szlam (Col. 12, Ln. 4-28

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and Col. 17, Ln. 53-Col. 18, Ln. 5). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to have included this screen-scraping feature as taught in Szlam in order to have provided the user with a method for consolidating multiple sources of information located on various screens as recited in Szlam (Col. 5, Ln. 25-Col. 6, Ln. 18).

17. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle as applied to Claim 22, above, and in further view of US Patent Number 6,694, 362 to Secor.

Doyle fails to teach the step of determining that at least one item of supplemental consumer information for one or more consumers is missing from the list of consumers and querying at least one of a plurality of network locations specifying demographic information to locate at least one of the missing items of supplemental consumer information. However this feature is well known in the art as evidenced by Secor. Secor, which is directed towards a method and system for network impact analysis, teaches a feature which determines that data is missing and a feature known as an "Action Tree" is used to query the appropriate data source to locate the missing information (Col. 8, Ln. 31-38). At the time the invention was made one of ordinary skill in the art would have been motivated to add the "Action Tree" feature to the system of Doyle with the motivation of 1) ensuring that all supplemental consumer information on a given user was available to the system and 2) provide a means to obtain missing information in obtain a complete record (these reasons are recited in Secor) (Col. 8, Ln. 30-46).

18. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle as applied to Claim 30, above, and in further view of US Patent Number 6,694, 362 to Secor.

Doyle fails to teach the step of determining that at least one item of supplemental consumer information for one or more consumers is missing from the list of consumers and

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querying at least one of a plurality of network locations specifying demographic information to locate at least one of the missing items of supplemental consumer information. However this feature is well known in the art as evidenced by Secor. Secor, which is directed towards a method and system for network impact analysis, teaches a feature which determines that data is missing and a feature known as an "Action Tree" is used to query the appropriate data source to locate the missing information (Col. 8, Ln. 31-38). At the time the invention was made one of ordinary skill in the art would have been motivated to add the "Action Tree" feature to the system of Doyle with the motivation of 1) ensuring that all supplemental consumer information on a given user was available to the system and 2) provide a means to obtain missing information in obtain a complete record (these reasons are recited in Secor) (Col. 8, Ln. 30-46).

Conclusion

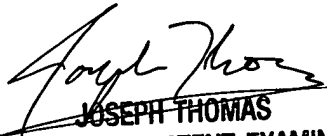
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (703) 605-4441. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RWM
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